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Docket No. AUS920010352US1 Serial No. 09/876,118

Atty: Mark S. Walker

Applicant: Bhogal, et al.

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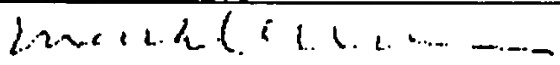
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	Filing Date	June 7, 2001	
	First Named Inventor	Bhogal	
	Art Unit	2151	
	Examiner Name	Collins, Scott M	
(to be used for all correspondence after initial filing)		Attorney Docket Number	AUS920010352US1
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Printed name	Mark S. Walker		
Date	Nov. 1, 2005	Reg. No.	30,689

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In re Application of:  
**Kulvir Singh Bhogal *et al***

Serial No.: 09/876,118

Confirmation No.: 1243

Filed: June 7, 2001

Title: **Automatic Download of Web  
Content in Response to an Embedded  
Link in An Electronic Mail Message**


§  
§ Group Art Unit: 2151  
§  
§ Examiner on FOA: **Collins, Scott M.**  
§ Examiner in PAIR: **Swearingen,  
Jeffrey R.**  
§  
§  
§ Atty Docket No.: **AUS920010352US1**  
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Date

  
Mark S. Walker

**APPEAL BRIEF**

**Dear Sir:**

This is an Appeal Brief filed pursuant to 37 CFR § 41.37 in response to the Final Office Action of June 1, 2005. A Notice of Appeal was filed by facsimile on September 1, 2005 to an incorrect US PTO facsimile number (571-273-0140.) When informed of the incorrect filing, the Notice of Appeal was filed by facsimile on October 29, 2005 to the correct number (571-273-8300.) Any extension fees due have been authorized to be charged to Deposit Account No. 09-0447 under the provisions of MPEP §509.01 in the application transmittal dated June 7, 2001.

**REAL PARTY IN INTEREST**

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The real party in interest is the patent assignee, International Business Machines Corporation ("IBM"), a New York corporation having a place of business at Armonk, New York 10504.

### **RELATED APPEALS AND INTERFERENCES**

There are no related appeals or interferences.

### **STATUS OF CLAIMS**

Claims 1-12 were originally filed in this case. Claims 1-12 stand finally rejected under 35 USC §102(b). The final rejection of Claims 1-12 was appealed in the Notice of Appeal.

### **STATUS OF AMENDMENTS**

No amendments were submitted after final rejection. The claims as currently presented are included in the Appendix of Claims that accompanies this Appeal Brief.

### **SUMMARY OF CLAIMED SUBJECT MATTER**

Applicants provide the following concise summary of the claimed subject matter on appeal according to 37 CFR § 41.37(c)(1)(vii), including references to specification by page and line number and to the drawings, if any, by reference characters.

The presently claimed invention is directed to a method, system and program product for improving the handling of e-mail messages containing hypertext links (or hyperlink) to web content. E-mail messages may be sent from one computer user to another and may contain text and a hypertext link to content stored on the World Wide Web (or simply, Web) (Specification, page 1, lines 37-39 and lines 20-26.) Current e-mail systems allow

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the user to request display of linked content by selecting the hypertext link but the user must wait while the content is located and downloaded to the user's computer (page 1, line 40 – page 2, line 9.)

Claim 1 is directed to a method for delivering Web content within the body section of an e-mail message in a distributed computer system with a server (Fig. 1, 22, 26 and Fig. 3, 80) and a client (Fig. 1, 20, 30a, 30b, 30c and Fig. 3, 32.) The server (80) receives a mail message containing at least one hyperlink (page 8, lines 35-42, Fig. 4, 402.) The server downloads (Fig. 4, 404) the Web content associated with the hyperlink into the message store (Fig. 3, 94) at the server. Finally, the mail message is transmitted to the client (Fig. 3, 32) with both the message text and the Web content corresponding to the hyperlink (page 9, 1-6, Fig. 4, 408.) With this method, the client does not need to wait for the hyperlink to be accessed and downloaded since the Web content has already been located and is transmitted with the message (page 9, 1-6.)

The second claim builds on this system by recognizing, at the server (80), when a hyperlink is common among several mail messages (page 9, 11-15, Fig. 5, 504.) The first reference to a hyperlink will cause the Web content to be downloaded and stored in the server message store (94), (Fig. 5, 512.). When a common hyperlink is recognized (504), each incoming mail message with the common hyperlink is tagged (Fig. 5, 506) with a reference to the message store. When the tagged mail message is sent to the client (32) (Fig. 5, 508), the hyperlink is parsed and the Web content is either sent with the message or maintained as a link on the local server (Fig. 5, 510) (page 9, 16-26.)

Claim 3 describes the process for detecting whether the referenced Web content exceeds a predetermined size, and, if so, compressing the Web content at the server (page 9, 32-25.)

Claim 4 detects whether the client has established a preset time for downloading messages containing Web content (page 10, lines 2-6) and, if so, downloading the Web content and caching the message and Web content at the server (80) until the preset time

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(page 10, 6-10.)

Claims 5-8 are directed to a distributed computer system (Fig. 1) with means for carrying out the method or processes of claims 1-4.

Claims 9-12 are directed to a computer program product (discussed on page 3, lines 25-30) for performing the methods or processes of claims 1-4.

All references to the specification identify descriptions and discussions that are part of the detailed descriptions of exemplary embodiments of the present invention in the present application. Such descriptions and discussions are not limitations of the claims in the present application. The only limitations of the claims are set forth in the claims themselves.

### GROUND OF REJECTION

Claims 1-12 stand rejected under 35 USC §102(b) as being anticipated by U.S. Patent Number 5,903,723 to Beck *et al.*

### ARGUMENT

Claims 1-12 stand rejected under 35 USC § 102(b) as being anticipated by Beck *et al.* (hereafter Beck.)

The Examiner argues that Beck teaches the limitations of the presently claimed invention. Applicants respectfully disagree.

Anticipation under 35 USC §102 requires that the applied reference teach each and every claim element. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."

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*Verdegall Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Claim 1 of the present invention includes the following elements:

*1. In a distributed computer system including a server and a client, the server including a message store, a method for delivering Web content within a body section of electronic mail messages comprising:*

*[a]receiving at a server, at least one mail message containing an embedded hyperlink;*

*[b]downloading Web content associated with the hyperlink into the message store at the server; and*

*[c]transmitting the mail message and the corresponding Web content for display at the client. (Reference letters added.)*

The Examiner argues that elements a-c are taught by Beck at column 5, lines 6-33 and that element b is additionally shown at column 13, lines 31-39 (Final Office Action, Mailed 6/2/05, page 3.)

Beck, at column 5, line 6 discusses the process of sending an e-mail with a link to an attachment rather than sending the attachment itself.

In the e-mail message format 400 of the present invention, when a user such as PC 210 of FIG. 2 wishes to send an attachment with an e-mail message to a user such as PC 212, the e-mail message 401 is transmitted along with a relatively small attachment reference 402, instead of actually transmitting the entire attachment file along with e-mail message 401 as is done in prior art e-mail systems. Thus, instead of transmitting the attachment by value, the attachment is transmitted 'by reference.' (Beck, col. 5, lines 8-16.)

The Beck reference later in col. 5 describes an ability to use an internet hyperlink as the attachment reference (Beck, col. 5, line 60 -- col. 6, line 7.) Beck then states, "In this manner, network bandwidth and resources are utilized more efficiently as there is no need to actually transmit the attachment 420 over the network unless a recipient of the

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corresponding e-mail message 401 is interested in viewing or otherwise using attachment 420." (Beck, col. 6, lines 8-12.)

Thus, Beck describes a system that sends an e-mail message with an embedded hyperlink that must be selected by the user to read the attachment. This is the type of prior art system the present invention seeks to improve (see Specification, page 1, line 37 to page 2, line 11.) In particular, the e-mail user must wait while the link is resolved and network content downloaded. The present invention overcomes this problem by resolving the hyperlink at the server and sending the referenced Web content to the client system in the body of the e-mail.

Thus, there is no teaching in Beck of:

*[b]downloading Web content associated with the hyperlink into the message store at the server;*

or of:

*[c]transmitting the mail message and the corresponding Web content for display at the client.*

With respect to element [b], Beck does not teach resolving a Web hyperlink and downloading the content referenced. The present invention is directed to handling e-mail that references any Web content through a hyperlink in contrast to Beck who stores an attachment in a web accessible server for later access. Web content in the present invention includes previously stored content in computers of various libraries, businesses, or federal agencies (see Specification, page 4, lines 9-11.) The presently claimed invention is not limited to attachment handling.

Element [b] of claim 1 is directed to accessing the Web content referenced by a hyperlink and then downloading that content to a mail server (Specification, page 8, lines 38-41.) Beck does not teach or suggest resolving a hyperlink and downloading the referenced content.



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Element [c] of claim 1 is directed to "transmitting the mail message and the corresponding Web content for display at the client." Beck does not teach or suggest this element, and, in fact, teaches against the combined transmission of the message and content. The goal of Beck's invention is to reduce network transmission load (see above quoted passage from Beck, col. 6, lines 8-12.) Beck removes the attachment and transmits only the mail message and a reference (col. 5, lines 47-54.)

Therefore, it is respectfully submitted that Beck does not anticipate claim 1 under 35 USC § 102 because it does describe directly or indirectly each and every element of the claimed invention. It is respectfully submitted that the Examiner has failed to identify any portion of Beck that describes elements [b] or [c] of Beck.

Independent claims 5 and 9 are directed to a distributed computer system and computer program product for delivering web content within the body of an electronic mail message. Both claims contain elements similar to elements [b] and [c] of claim 1. It is respectfully submitted that Examiner has failed to establish that Beck describes either element or their analogues in claims 5 and 9. It is therefore respectfully submitted that claims 5 and 9 are patentable over Beck under 35 USC § 102.

The Examiner argues that claims 2, 6, and 10 are anticipated by Beck. Claims 2, 6, and 10 depend upon independent claims 1, 5 and 9 and are respectfully submitted to be patentable over Beck for the reasons set forth above.

The Examiner argues that Beck teaches the final element of claim 2 "*parsing the hyperlink when a tagged message is sent to the client*" at col. 5, line 34 – col. 6, line 12 and col. 8, line 56 – col. 9, line 16. These sections of Beck describe removal of attachments and replacing with an attachment reference as described above. There is no teaching of sending the Web content with the e-mail (and in fact, Beck teaches against it.) The claimed "parsing" step is described in the Specification on page 9, lines 22-26 as "[A]ccordingly, when a tagged message is retrieved by a client, the hyperlink is parsed and the proper content is sent to the client from the message content store."

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The Examiner has failed to point out where Beck describes each and every element of claims 2, 6, and 10 and it is respectfully submitted that these claims are patentable over Beck under 35 USC § 102.

The Examiner argues that claims 3, 7, and 11 are anticipated by Beck. Claims 3, 7, and 11 depend upon independent claims 1, 5 and 9 and are respectfully submitted to be patentable over Beck for the reasons set forth above.

In addition, the Examiner has failed to point out any description in Beck that teaches testing the size of Web content accessed using a hyperlink in a e-mail message and, in response to the test, compressing the content before storing it on the server. The Examiner's reference to Beck, col. 6, lines 38-60 is inapplicable. That section of Beck teaches compression of an attachment before creating a reference and not after such a reference is resolved.

Thus, it is respectfully submitted that claims 3, 7, and 11 are patentable over Beck under 35 USC § 102.

The Examiner argues that claims 4, 8, and 12 are anticipated by Beck. Claims 4, 8, and 12 depend upon independent claims 1, 5 and 9 and are respectfully submitted to be patentable over Beck for the reasons set forth above.

The Examiner suggests that Beck col. 13, lines 31-39 describe the elements of claims 4, 8 and 12. Applicants respectfully disagree.

Claim 4 states:

*The method of claim 1 further comprising:*

*determining whether the client has a preset time for downloading messages containing Web content; and*

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*in response to determining that a preset time for downloading Web content exists, caching the message and Web content at the server until the preset time is reached.*

Beck states:

If accepted, the URL 627 and a corresponding hypertext link (which allows the recipient to read the attachment pointed to with pointer 630 by the URL) are incorporated onto the recipient's mail page, stored at server 620. Therefore, *at a later time*, the recipient 622 can view the incoming mail page and retrieve messages..." (Beck, col. 13, lines 31-36, emphasis added.)

The process described by Beck involves creating a web server for the recipient to collect mail messages from other users. The server allows the recipient to check mail at "a later time" but does not teach or suggest the claimed steps of determining whether the user has set a predetermined time for message download and caching the messages and Web content at the server until that time.

Therefore, it is respectfully submitted that Beck does not describe each and every element of claims 4, 8, and 12 and that these claims are therefore patentable over Beck under 35 USC § 102.

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### Conclusion

Claims 1-12 stand rejected under 35 USC § 102(b) as being anticipated by Beck. As shown above, Beck does not teach each and every element of the claims as required to find anticipation. It is therefore respectfully submitted that claims 1-12 are patentable and should be allowed.

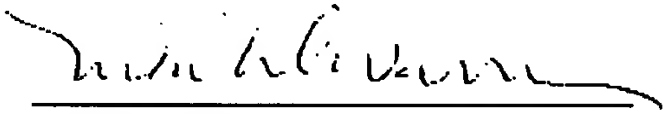
In view of the forgoing arguments, reversal of the Examiner's rejection of claims 1-12 is earnestly requested.

The Commissioner is hereby authorized to charge or credit Deposit Account No. 09-0447 for any fees required or overpaid.

Respectfully submitted,

Bhogal *et al* by:

Date: 11-1-05

  
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**APPENDIX OF CLAIMS**  
**ON APPEAL IN PATENT APPLICATION OF**  
**Bhokal *et al* – Serial No. 09/876,118**

**CLAIMS**

What is claimed is:

1. In a distributed computer system including a server and a client, the server including a message store, a method for delivering Web content within a body section of electronic mail messages comprising:
  - receiving at a server, at least one mail message containing an embedded hyperlink;
  - downloading Web content associated with the hyperlink into the message store at the server; and
  - transmitting the mail message and the corresponding Web content for display at the client.
2. The method of claim 1 further comprising:
  - detecting, at the server, a plurality of incoming mail messages containing a common hyperlink; tagging each incoming mail message containing the common hyperlink;
  - storing one copy of the Web content associated with the common hyperlink in the message store at the server; and
  - parsing the hyperlink when a tagged message is sent to the client.
3. The method of claim 1 further comprising:
  - determining whether the Web content exceeds a predetermined size; and
  - in response to determining that the Web content exceeds a predetermined size, compressing the Web content that exceeds the predetermined size, at the server.
4. The method of claim 1 further comprising:

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determining whether the client has a preset time for downloading messages containing Web content; and

in response to determining that a preset time for downloading Web content exists, caching the message and Web content at the server until the preset time is reached.

5. A distributed computer system including a server and a client, the server including a message store, for delivering Web content within a body section of electronic mail messages comprising:

means for receiving at a server, at least one mail message containing an embedded hyperlink;

means for downloading Web content associated with the hyperlink into the message store at the server; and

means for transmitting the mail message and the corresponding Web content for display at the client.

6. The system of claim 5 further comprising:

means for detecting, at the server, a plurality of incoming mail messages containing a common hyperlink;

means for tagging each incoming mail message containing the common hyperlink;

means for storing one copy of the Web content associated with the common hyperlink in the message store at the server; and

means for parsing the hyperlink when a tagged message is sent to the client.

7. The method of claim 5 further comprising:

means for determining whether the web content exceeds a predetermined size; and

in response to determining that the Web content exceeds a predetermined size, means for compressing the Web content that exceeds the predetermined size, at the server.

8. The method of claim 5 further comprising:

means for determining whether the client has a preset time for downloading messages containing Web content; and

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in response to determining that a preset time for downloading Web content exists, means for caching the message and Web content at the server until the preset time is reached.

9. A computer program product having computer code on a computer readable medium for delivering Web content within a body section of electronic mail messages comprising:

instructions for receiving at a server, at least one mail message containing an embedded hyperlink;

instructions for downloading Web content associated with the hyperlink into the message store at the server; and

instructions for transmitting the mail message and the corresponding Web content for display at the client.

10. The product of claim 9 further comprising:

instructions for detecting, at the server, a plurality of incoming mail messages containing a common hyperlink;

instructions for tagging each incoming mail message containing the common hyperlink;

instructions for storing one copy of the Web content associated with the common hyperlink in the message store at the server; and

instructions for parsing the hyperlink when a tagged message is sent to the client.

11. The product of claim 9 further comprising:

instructions for determining whether the web content exceeds a predetermined size; and

in response to determining that the Web content exceeds a predetermined size, instructions for compressing the Web content that exceeds the predetermined size, at the server.

12. The product of claim 9 further comprising:

instructions for determining whether the client has a preset time for downloading messages containing Web content; and

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in response to determining that a preset time for downloading Web content exists, instructions for caching the message and Web content at the server until the preset time is reached.